REMARKS

Claims 1-22 are pending.
Claims 1, 3, 4, 5, 8, 9, 10, 11 and 21 are amended.

35 USC 112, second paragraph

Claims 1, 16 and 21 are rejected under 35 USC 112, second paragraph as being indefinite.

The Examiner states that it is unclear what "a small particle size pigment" would include. Applicants have amended claim 1 to include a size range (40 to 100 m^2/g) for the small particle size pigment. This amendment is supported by the disclosure on page 5, line 17.

No new matter is added.

However, Applicants respectfully point out that the term "small particle size pigment" does not occur in claims 16 or 21. To the contrary claims 16 and 21 use the term a "transparent pigment".

As stated in the disclosure on page 5, lines22-23:

> "In general, pigments having a surface area within the above indicated ranges are referred to as transparent pigments due to their lack of light scattering."

The Applicants assume there to be no 35 USC 112, second paragraph rejection in reference to the term "transparent pigment" as this is not indefinite and a well known art defined term.

Claim Analysis

The Examiner assumes that "effect pigment", "small particle size pigment" and flop enhancing agent" are all interchangeable. Furthermore, the Examiner states "any three pigments which make up a coating composition would technically meet applicant's required primary limitation."

The claim encompasses compositions containing an effect pigment, a small particle size pigment having a specific surface area in the range from 40 to 100 m2/g and a flop enhancing agent selected from the group consisting of optionally substituted halogenated copper phthalocyanines.

Effect pigments are well known in the art and discussed on page 10, lines 13-15.

> ..effect pigments, such as coated and uncoated micas, aluminum flakes, multilayered color shifting flake pigments and graphite flakes."

The flop enhancing agent must be selected from at least one optionally substituted **halogenated** copper phthalocyanine.

35 USC 102 (b)

Claims 1-22 are rejected under 35 USC 102(b) as being anticipated by Hendi, et al. US5618343.

The Applicants have amended claim 1 to require at least one flop enhancing agent selected from the group consisting of optionally substituted halogenated copper phthalocyanines.

Claims 3, 4, 5, 8, 9, 10, 11 and 21 are all further amended to make consistent with the claim 1 amendment. That is the pigment compositions(claims 10 and dependent claims) and method claim (claim 21) all now require the presence of at least on optionally substituted halogenated copper phthalocyanine.

The disclosure of US 5,618,343 reads on a great number of suitable copper phthalocyanine compounds. See column 2, lines 3-39. The generic formula for the phthalocyanine in column 2 literally encompasses hundreds of compounds. The examples of US '343 all use copper phthalocyanine monosulfonic acid as the flop enhancing agent. There are no examples or any mention of specific optionally substituted **halogenated** copper phthalocyanines within the US '343 disclosure.

Thus the applicants believe this reference (US '343) does not disclose optionally substituted halogenated copper phthalocyanines with "sufficient specificity to constitute an anticipation under the statute.

The Applicants refer the Examiner to MPEP 2131.03:

When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the stature." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the

claims. The unexpected results may also render the claims unobvious. The question of "sufficient specificity" is similar to that of " clearly envisaging" a species from a generic teaching.

The proper test for anticipation is whether the instant claims read on the actual compounds shown in the reference, not where there is overlap between a generic teaching and the claimed invention.

As the present invention claims an optionally substituted halogenated copper phthalocyanine, and this particular derivative is not disclosed in US'343 with sufficient specificity, the Applicants aver that the 102(b) rejection is overcome.

In the event, that the Examiner considers the 102(b) rejection overcome but then raises an obviousness rejection, the Applicants point the Examiner to the data displayed in table IV on page 10 of the present disclosure.

Table IV shows two year South Florida Exposure and compares the delta E for flop enhancing agent of US '343 with the flop enhancing agent of the present disclosure. The data supports the invention that the halogenated copper phthalocyanine acts an excellent flop enhancing agent (see Table I) yet retains the durability characteristics required for an automotive pigment. The durability characteristics imparted to the composition by incorporation of the optionally substituted halogenated copper phthalocyanine is an unobvious advantage not recognized in the US '343 reference.

Claims 1, 10, 16 and 21 are rejected under 35 USC 102(b) as being anticipated by Okura, et al., US 5,112,403.

The Examiner states that Okura discloses a pigment comprising a flop enhancing agent (copper phthalocyanine pigment), small particle size pigment and effect pigment.

The generic disclosure of Okura reads:

Column 1, lines 60 to 67

There is provided a coating composition comprising plate-like iron oxide particles having an average particle diameter of 0.5 to 5.0 um, a lamellar thickness of 50 to 500 angstroms and a plate ratio of 50:1 to 500:1, at least one pigment selected from the group consisting of a coloring pigment, a mica pigment and a metal powder pigment,.....

Examiner refers to column 4, lines 21-55 stating that all the element of the present invention are mentioned, thus anticipation.

Okura never discloses combining an optionally substituted **halogenated** copper phthalocyanine with an effect pigment and a small particle size pigment.

The Applicants have considered all of the examples and disclosure of Okura. There is only one example which uses a copper phthalocyanine at all. See example 3 (or mixture E), column 8. This copper phthalocyanine is referred to as copper phthalocyanine blue. The Applicants enclose a Chemical Abstract printout of copper phthalocyanine blue. Note that this compound contains **no halogen substitution**.

Thus Okura does not disclose an essential element of the present invention (halogenated copper phthalocyanine) and there is no anticipation. In order for there to be anticipation, the reference must disclose all elements of the invention. As Okura does not, he does not anticipate and the rejection is overcome.

Double Patenting Rejection

Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being upatentable over claims 1-22 of US 5,618,343.

Although US '343 may appear to encompass some of the present claims, this domination is not the determining factor.

The determining factor in deciding whether or not there is double patenting is the existence *vel non* of patentable difference between two sets of claims (*In re Borah*, 354 F.2d 1009, 148 USPQ 213).

The claims as they now stand require the presence of a halogenated copper phalocyanine. US '343 although generically covers halogenated copper phatlocyanines as flop-enchancing agents never specifically mentions their use. As argued above, they are not disclosed with sufficient specificity.

Furthermore, the data shown in Table IV on page 20 shows the halogenated copper phthalocyanine flop-enhancing agents to show surprising durability when compared to the compositions exemplified in

US '343. US ' 343 shows a delta E of 3.2. The instant flop enhancing agent shows a delta E of 1.6 (lower delta E is better). This is an improvement in delta E of 50 %.

Because the compositions of the present invention show surprising durability advantages, the Applicants believe the double patenting rejection is improper and requests reconsideration

Reconsideration and withdrawal of the rejection of claims 1-22 is respectfully solicited in light of the remarks and amendments *supra*. Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-22 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

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Enclosure: Chemical Abstract printout of structure and petition for one(1) month extension.

L1 ANSWER 1 OF 1 REGISTRY COPYRIGHT 2006 ACS on STN
RN 147-14-8 REGISTRY
ED Entered STN: 16 Nov 1984
CN Copper, [29H,31H-phthalocyaninato(2-)-κN29,κN30,κN31,.ka
ppa.N32]-, (SP-4-1)- (9CI) (CA INDEX NAME)
OTHER CA INDEX NAMES:
CN 29H,31H-Phthalocyanine, copper complex
CN 29H,31H-Phthalocyanine, copper deriv.
OTHER NAMES:
CN (Phthalocyaninato)copper
CN α-Copper phthalocyanine
CN α-Copper phthalocyanine blue
CN α-Phthalocyanine blue
CN β-Copper phthalocyanine blue
CN β-Phthalocyanine blue
CN ε-Copper phthalocyanine
CN 79S26C
CN 79S26C chip
CN Accosperse Cyan Blue GT
CN Acnalin Supra Blue G
CN Acramin Blue F 3G
CN Akrochem 626
CN Aqualine Blue
CN Aquis BW 3571
CN Arlocyanine Blue PS
CN Aztech Chemisperse Cyan 1541
CN B 8M25
CN Bahama Blue BC
CN Bahama Blue BNC
CN Bahama Blue Lake NCNF
CN Bahama Blue WD
CN Bermuda Blue
CN BFD 1121
CN BL 1531
CN Blue 7110V
CN Blue GLA
CN Blue GLSM
CN Blue Microdis
CN Blue phthalocyanaine α-form
CN Blue pigment
CN Blue Toner GTNF
CN BT 4651
CN C.I. 74160
CN C.I. Pigment Blue 15
CN C.I. Pigment Blue 15:1
CN C.I. Pigment Blue 15:2
CN C.I. Pigment Blue 15:3
CN C.I. Pigment Blue 15:4
CN C.I. Pigment Blue 15:5
CN C.I. Pigment Blue 15:6
CN Calcotone Blue GP
CN Ceres Blue BHR
CN CFP-FF 775B
CN Chromatex Blue BN
CN Chromofine Blue 4920
CN Chromofine Blue 4920G
CN Chromofine Blue 4927
CN **Copper phthalocyanine blue**
ADDITIONAL NAMES NOT AVAILABLE IN THIS FORMAT - Use FCN, FIDE, or ALL for

DISPLAY

DR 12767-67-8, 10482-39-0, 11097-56-6, 11129-84-3, 177529-54-3, 177646-05-8, 158853-86-2, 172308-31-5, 172826-46-9, 53802-06-5, 57916-96-8, 57425-52-2, 55819-49-3, 59518-91-1, 59966-88-0, 64333-57-9, 95660-31-4, 95917-74-1, 96024-35-0, 104921-99-5, 51331-32-9, 115284-42-9, 60880-51-5, 60937-79-3, 61489-66-5, 61489-77-8, 61537-10-8, 109675-77-6, 109766-95-2, 66121-19-5, 37223-81-7, 69431-77-2, 78170-27-1, 78413-59-9, 85255-95-4, 85256-77-5, 92909-14-3, 90452-20-3, 34567-54-9, 39378-75-1, 39473-10-4, 53028-77-6, 175386-67-1, 184007-78-1, 211564-97-5, 211925-80-3, 213190-86-4, 244244-86-8, 345338-75-2, 392718-62-6

MF C32 H16 Cu N8

CI CCS, COM

LC STN Files: AGRICOLA, ANABSTR, BIOSIS, BIOTECHNO, CA, CAOLD, CAPLUS, CASREACT, CBNB, CHEMCATS, CHEMLIST, CIN, CSCHEM, CSNB, DETHERM*, DIOGENES, EMBASE, GMELIN*, HSDB*, IFICDB, IFIPAT, IFIUDB, IPA, MEDLINE, MRCK*, MSDS-OHS, NIOSHTIC, PIRA, PROMT, RTECS*, SPECINFO, TOXCENTER, USPAT2, USPATFULL, VTB

(*File contains numerically searchable property data)

Other Sources: DSL**, EINECS**, TSCA**

(**Enter CHEMLIST File for up-to-date regulatory information)

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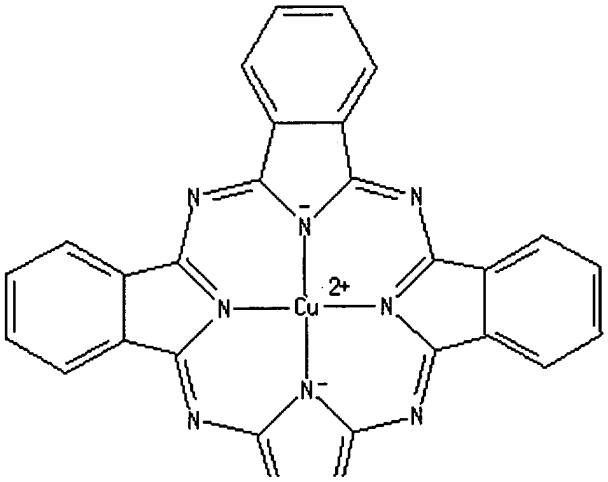
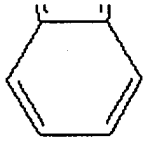


PAGE 2-A



PROPERTY DATA AVAILABLE IN THE 'PROP' FORMAT

13775 REFERENCES IN FILE CA (1907 TO DATE)

STN Columbus

1117 REFERENCES TO NON-SPECIFIC DERIVATIVES IN FILE CA
13805 REFERENCES IN FILE CAPLUS (1907 TO DATE)
134 REFERENCES IN FILE CAOLD (PRIOR TO 1967)